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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/879,070	06/19/1997	JEROME D JOHNSON	7709.130US01	9054
7590	03/09/2004		EXAMINER	
Richard J Gregson Shumaker & Sieffert P A 8425 Seasons Parkway Suite 105 St Paul, MN 55125			KALINOWSKI, ALEXANDER G	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 03/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	08/879,070	JOHNSON ET AL.
	Examiner	Art Unit
	Alexander Kalinowski	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. Claims 1-10 are presented for examination. Applicant filed a request for reconsideration of the rejection of claims 1-10 based on 35 USC 103. After careful consideration of Applicant's arguments, the Examiner finds Applicant's arguments nonpersuasive and maintains the rejection of claims 1-10 based on 35 USC 103 (see Paper No. 28). Since the Examiner finds Applicant's arguments to be nonpersuasive to the previous rejection of claims 1-10 based on 35 USC 103, the rejection of claims 1-10 is a final rejection of the claims.

Response to Arguments

2. Applicant argues that the combination of Dworkin, SFA, Joseph and Bennett fail to disclose all the limitations of independent claims 1 and 8-10 and furthermore, provide no motivation to combine the references. The Examiner disagrees. As a preliminary matter, the Examiner refers the Applicant to the response to Applicant's arguments in Paper No. 28. Furthermore, the Examiner disagrees with Applicant's characterization of the SFA reference. It is clear that from the reference that SFA discloses a problem in configuring, ordering and pricing automobiles using manual methods. That problem was identified as orders that are rejected (page 1, lines 22-35). Furthermore, SFA discloses that the orders that were rejected by the factory were rejected because they were unbuildable (page 1 lines 34-35). Therefore, a software product (that was developed by the assignee of the instant application) was purchased to automate configuring, ordering and pricing automobiles. SFA discloses that this product has virtually

eliminated the factory reject rate (page 1, lines 36-40). But, as discussed above, the article disclosed that the reason orders were rejected (i.e. reject rate) was because the orders were unbuildable. Therefore, since the reject rate has been virtually eliminated, and since the software product is responsible for virtually eliminating the factory reject rate, it is clear that the product has virtually eliminated the reject rate by ensuring that the orders are buildable. Applicant's reasoning that the software somehow improves the user's judgment in selecting options that make the order buildable simply does not make any sense and ignores two problems identified by SFA associated with the manual process of configuring vehicle orders, namely, the considerable amount of time it takes to generate an order manually and the large factory reject rate (i.e. about 25% of orders) of orders submitted manually (see page 1, lines 31-35). Furthermore, Applicant claims that the SFA reference suggests that some of the factory reject rate was caused by construction of unbuildable products and that this assumption is not supported by the reference. The Examiner disagrees. SFA clearly discloses on the first page that "about 25% of orders were ultimately rejected as clearly unbuildable" (see page 1, lines 34-35). Thus, SFA clearly states the reason for the high factory reject rate of manual orders; the orders were unbuildable. Applicant further argues that the GM Prospec product configurator virtually eliminates the factory reject rate and therefore one skilled in the art could not tell if the product was checking to see if the product was buildable. The Examiner disagrees. As explained above, the Examiner position is that one of ordinary skill would have understood that the GM Prospec product is checking to see if the product is buildable. SFA discloses that the reject rate has been virtually

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eliminated. Furthermore, no software product is completely foolproof. For example, an aggressive salesman may assure a customer that any or all options that the customer wishes may be included in the customer order even though the configurator indicates otherwise in order to close the sale. The salesman sends the order anyway knowing that it will get rejected. When the rejected order comes back, the salesman will then present a next best alternative to the customer. Therefore, Applicant's arguments directed to the SFA reference are deemed nonpersuasive.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has cited motivation to combine directly from the references. Applicant admits that the Examiner cited the motivation to combine directly from the prior art references (see Paper No. 29, page 5). Therefore, the Examiner cited explicit motivation to combine the references and Applicant's arguments are deemed nonpersuasive.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

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If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

Alexander Kalinowski

Primary Examiner

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3/7/04